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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,154

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Yong Cheol Park

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EXAMINER

PENDLETON, DIONNE

ART UNIT

PAPER NUMBER

2627

MAIL DATE

DELIVERY MODE

06/10/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/563,154	PARK, YONG CHEOL	
	Examiner	Art Unit	
	DIONNE PENDLETON	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) 3-8 and 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Interview Summary mailed 5/4/11, have been fully considered and are persuasive. The finality of official action mailed 2/28/11 has been withdrawn.

Election/Restrictions

2. **Claims 3-8, 10-17 are withdrawn** from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/3/2009.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. **Claims 1, 9 and 18-22** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1, 4, 9 and 12 of U.S. Patent No. 7,613,874.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims include all of the limitations of the instant application claims, respectively. The patent claims also include additional limitations. As such, the instant application claims are anticipated by the patent claims and are therefore not patentably distinct therefrom. (See *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2D 1869, "a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim", *In re Goodman*, 29 USPQ2d 2010, "Thus, the generic invention is 'anticipated' by the species of the patented

invention" and the instant "application claims are generic to species of invention covered by the patent claim, and since without terminal disclaimer, extant species claims preclude issuance of generic application claims").

Regarding claim 1,

Park'874 teaches an overwrite method of an optical disc, comprising the steps of: confirming whether a recording mode applied to the optical disc is a sequential recording mode by reading recording mode information recorded in a temporary management area of the optical disc (**claim 1 recites, "referring to a list of open sequential recording ranges recorded in a temporary disc management area of the recording medium upon receiving an overwrite command"**), in which data is recorded sequentially onto sequential recording ranges allocated to a data area of the optical disc (**claim 1 recites, "dividing the user data area into a plurality of sequential recording ranges"**), wherein each of the sequential recording ranges is one of an open sequential recording range having a next writable area or a closed sequential recording range having no writable area (**claim 1 recites, "...a list of open sequential recording ranges..."**);

performing an overwrite for an overwrite-requested data onto a replacement recording area (**claim 1 recites, "A method for overwriting data in a recording medium..."**, and **"...and performing a replacement record operation"**),

wherein if the overwrite is requested in an open sequential recording range, a next writable area within the open sequential recording range is identified as the

replacement recording area (**claim 1 recites, “...performing a replacement record operation at a next writable area of an open one of the sequential recording ranges...”**).

Regarding claim 9,

Park’874 teaches recording after performing an overwrite, location information of the replacement recorded area as management information (**claim 4 recites, “recording position information of an area indicated by the overwrite command and position information of a replacement record area replacing the area as a single entry in the temporary disc management area.”**)

Regarding claim 20,

Park’874 teaches recording location information in a temporary management information (**claim 4 recites, “recording position information of an area indicated by the overwrite command and position information of a replacement record area replacing the area as a single entry in the temporary disc management area.”**)

Regarding claim 18,

Park’874 teaches an apparatus for overwriting data on an optical disc, comprising: a pickup unit configured to write data on the optical disc (**claim 9 recites “a pickup configured to record/reproduce data in/from the recording medium”**); and a controller, operatively coupled to the pick up unit (**claim 9 recites, “a microprocessor configured to control the pickup”**), configured to control confirming whether a recording mode applied to the optical disc is a sequential recording mode by

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reading recording mode information recoded in a temporary management area of the optical disc (claim 9 recites, in which data is recorded sequentially onto sequential recording ranges allocated to a data area of the optical disc (“...**perform a replacement record operation at a next writable area of an open one of the sequential recording ranges by referring to a list of open sequential recording ranges...**”), wherein each of the sequential recording ranges is one of an open sequential recording range having a next writable area and a closed sequential recording range having no writable area (claim 9 recites, “**perform a replacement record operation at a next writable area of an open one of the sequential recording ranges..., the open sequential recording range having available writable area, and the closed sequential recording range having no available writable area**”); and wherein the controller is also configured to control the pickup unit to perform a replacement recording for an overwrite-requested data onto a replacement recording area (claim 9 recites, “**perform a replacement record operation at a next writable area**”), wherein if the overwrite is requested in an open sequential recording range, the controller identifies a next writable area within the open sequential recording range as the replacement recording area (claim 9 recites, “**perform a replacement record operation at a next writable area of an open one of the sequential recording ranges**”).

Regarding claims 19 and 21,

Park'874 teaches that the controller is configured to control the pickup unit to record location information of the overwrite requested area and the replacement recorded area in a temporary management information (**claim 12 recites, “the microprocessor is configured to control the pickup, the data processor, the servo, and the memory so as to record information associated with the sequential recording ranges in the recording medium as sequential recording range information into the temporary disc management area.”**)

Regarding claim 22,

Park'874 teaches an optical disc comprising a data area configured to allocate one or more sequential recording ranges (**claim 1 recites, “dividing the user data area into a plurality of sequential recording ranges”**), in a sequential recording mode in which data is recorded sequentially onto sequential recording ranges (**claim 1 recites, “recording data into at least one of the sequential recording ranges”**) wherein each of the sequential recording ranges is one of an open sequential recording range having a next writable area and a closed sequential recording range having no writable area (**claim 1 recites, “...a list of open sequential recording ranges recorded in a temporary disc management area of the recording medium upon receiving an overwrite command to a closed one of the sequential recording ranges”**); wherein if the overwrite is requested in an open sequential recording range, a next writable area within the open sequential recording range is identified as the

replacement recording area (**claim 1 recites, “and performing a replacement record operation at a next writable area of an open one of the sequential recording ranges”.**)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIONNE PENDLETON whose telephone number is (571)272-7497. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dionne H Pendleton/
Examiner, Art Unit 2627

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/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627